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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/675,415
Filing Date: September 29, 2000
Appellant(s): CRAWFORD ET AL.

Baker Botts
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/30/2006 appealing from the Office action mailed 10/21/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below:

NEW GROUND(S) OF REJECTION

Claims 15-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,774,868	Cragun et al.	6-1998
6,266,649	Linden et al.	6-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4-5, 8-13, 15, 18-19, 22-27, 29, 30, 33-34, 37-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Cragun et al. (5,774,868, Cragun hereinafter).

With respect to claims 1, 4, 5, 8, 9-13, 15, 18-19, 22-27, 29, 30, 33-34,37-42 Cragun teaches a system for rendering content according to availability data for at least one item (Abstract). A server operable to receive a content request from a user in a current interactive session, and in response to retrieve the requested content (i.e. the customer using an interactive device such as a telephone or a sale register makes a request to make a purchase and the requested purchase is made available to the customer)(col. 3, lines 66-, col. 4, lines 1-15); a rendering engine coupled to the server and operable to identify at least one rule within the user-requested content and concerning the item (col. 4, lines 15-27); the rendering engine further operable to render the requested content, including content concerning the item (col. 4, lines 15-27); a rules engine coupled to the rendering engine and operable to receive availability data for the item (i.e. the in-store data relates to the inventory information of the item)(col. 17, lines 39-44); retrieve additional content according to the availability data for the item, the additional content being selected from among one or more stored content elements that concern the item

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(col. 4, lines 18-27); communicate the additional content concerning the item to the rendering engine for incorporation in the user-requested content (col. 17, lines 61-, col. 18, lines 1-6); the rendering engine further operable to render the user-requested content, including the additional content concerning the item (col. 4, lines 18-27 and lines 61-, col. 18, lines 1-6); the server further operable to communicate the rendered user-requested content to the user in the current interactive session to satisfy the user-supplied content request (Figures 1 and 2).

Claims 6-7, 14, 20-21, 28, 35, 36 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cragun.

Claims 6, 20 and 35 further recite that the availability data consist of inventory, delivery and pricing information. Since, Cragun teaches that the availability data includes inventory information and other information related to the products to be recommended such as the weather and the time of the item in order to recommend the most suitable item (col. 17, lines 32-44) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included delivery and pricing information of the item to better predict items that will be purchased by the customers. Claims 7, 21 and 36 further recite pricing information in accordance with a promising policy from multiple suppliers of the items. Official notice is taken that it is old and well known to receive pricing information from a variety of entities in accordance with a

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preset promising policy. For example, in electronic auctions pricing terms are pre-negotiated with the various suppliers or entities that are willing to fulfill a customer's order in order to provide consistency within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included pricing information in accordance with a promising policy from multiple suppliers of the items in order to achieve the above mentioned advantage.

With respect to claims 14, 28 and 43, Cragun teaches that the selected item are selected from availability for the item to which the recommendation is directed and a characteristic of a user to which the recommendation is to be presented (co. 17, lines 32-60). Cragun does not specifically teach that the profitability for the item to which the recommendation is directed and the item that the seller wishes to optimize. Official notice is taken that it is old and well known to taken into account the profitability and the items that the sellers want to optimize in the recommendation process. For example, real estate agents will try to sell their own listings in order to maximize their profits. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the profitability for the item to which the recommendation is directed and the item that the seller wishes to optimize in order to obtain the above mentioned advantage.

Claims 2-3, 16-17, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cragun in view of Linden et al. (6,266,649 hereinafter Linden).

Claims 2, 16 and 31 further recite that the server is a web server and that the request comprises a Hypertext Transfer Protocol request containing a Uniform Resource Locator for a particular page. Linden teaches collaborative recommendations using item-to-item similarity mappings. The user logs into the Amazon.com web server and requests information for a particular web page (see Figure 6). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Linden of the server being a web server and that the request comprises a Hypertext Transfer Protocol request containing a Uniform Resource Locator for a particular page because such a modification would provide world wide access to the system.

With respect to claims 3, 17 and 32 in addition to some of the limitations addressed above in the rejection to claims 2 and 16, the claims further recite that the rules are incorporated into the requested content. Since the combination of Cragun and Linden teach rules corresponding to the recommended item then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included incorporating the rules into the requested content because such a modification would allow for the convenience of allowing for the rules to be requested when necessary.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 7-10 and 12-14 fail to meet the above requirements.

(10) Response to Argument

Appellant argues that Cragun doesn't teach a rules engine that generates at least one availability request corresponding to the rule and concerning the item. The Examiner disagrees with Appellant because Cragun clearly teaches that the user request to purchase an item is sent to a server in order for the request to be fulfilled (col. 3, lines 66 to col. 4, lines 1-15). In addition Cragun teaches in col. 7, lines 60-62 that an item # corresponds to a stock number, inventory number and Figure 4 illustrates using the item # to recommend an item based on the item #, which corresponds to a stock and inventory number for the item selected by the user.

Appellant argues that Cragun doesn't teach identifying ones rules based on the user content concerning the item. Examiner disagrees because in Cragun, Figures 8-18, the items are classified and categorized in classes and according to its class, it recommends the additional items.

Appellant argues that Cragun automatically and without customer's knowledge collects data and that the promotion coupons are not requested by the customer. The Examiner wants to point out that the claims do not recite if the data collected about the purchases is sent with or without customer's knowledge or if the additional content (additional items) concerning the purchase is requested by the customer. The claims recite "receiving a content request from a userand in response to the user-supplied content request, to retrieve the user-requested content". The user-requested content is for the purchase of an item, which is taught by Cragun on col. 3, lines 66-, col. 4, lines 1-15, in Cragun the user request for the purchase of an item is sent to a server in order for the request of the purchase to be fulfilled (col. 3, lines 66-, col. 4, lines 1-15) and based on the user purchases, the system determines additional items likely to be purchased by the customer (Abstract and col. 4, lines 18-27). The claims do not recite that the user-request the additional content concerning the purchased item (sales promotions coupons for the items purchased) or if the user has any knowledge that this data is being collected and analyzed in order to provide or recommend additional items. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Linden teaches recommending additional items to a customer based on selected items using a web server to carry out the invention and therefore Cragun can be combined to include the server being a web server as taught by Linden because such a modification would provide world access to the system. Appellant is reminded that a person of ordinary skill in the art is presumed to have some knowledge about the art. Given the web server of Linden, one of ordinary skill in the art would have the knowledge or would know that the server being a web server would allow broader use of the system.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Raquel Alvarez/
Primary Patent Examiner
December 1, 2008

Conferees:

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James W. Myhre /J.WS.M./
Supervisory Patent Examiner, Art Unit 3688

Vincent Millin /V.M./
Appeals Practice Specialist

**A Technology Center Director or designee must personally approve the
new ground(s) of rejection set forth in section (9) above by signing below:**